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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,427	06/15/2007	Daniel Mark Wallaker	61771.US	6468
408 7590 04/27/2011 LUEDEKA, NEELY & GRAHAM, P.C. P O BOX 1871 KNOXVILLE, TN 37901				
EXAMINER GISHNOCK, NIKOLAI A				
ART UNIT 3715		PAPER NUMBER		
MAIL DATE 04/27/2011		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/596,427

Applicant(s)

WALLAKER ET AL.

Examiner

NIKOLAI A. GISHNOCK

Art Unit

3715

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

In response to applicant's reply filed 2/11/2011, claims 1-8 are pending.

Drawings

1. New drawings were received on 10/22/2010. The drawings are acceptable.

Claim Observations - 35 USC § 112

2. A claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3- prong analysis:

(A) the claim limitations must use the phrase "means for" or "step for";
(B) the "means for" or "step for" must be modified by functional language; and
(C) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function.

See MPEP 2181. With respect to the first prong of this analysis, a claim element that does not include the phrase "means for" or "step for" will not be considered to invoke 35 U.S.C. 112, sixth paragraph. If an applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant must either: (A) amend the claim to include the phrase "means for" or "step for" in accordance with these guidelines; or (B) show that even though the phrase "means for" or "step for" is not used, the claim limitation is written as a function to be performed and does not recite sufficient structure, material, or acts which would preclude application of 35 U.S.C. 112, sixth paragraph. See *Watts v. XL Systems, Inc.*, 232 F.3d 877, 56 USPQ2d 1836 (Fed. Cir. 2000); see also *Masco Corp. v. United States*, 303 F.3d 1316, 1327, 64 USPQ2d 1182, 1189 (Fed. Cir. 2002). Thus in the instant claim 6, the limitation "wherein means are provided to retention each of the loops" will not be treated under under 35 U.S.C. 112, sixth paragraph; the limitation will be treated as an intended use of the instrument until otherwise demonstrated.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Alexander et al. (US 6,929,481 B1), hereinafter known as Alexander.

5. Alexander discloses a dummy instrument for use in a simulator (a mock medical instrument, abstract), the instrument comprising a control body (endoscope, Figure 1, Item 22; 9:28-39) with user manipulatable angulation control (thumb lever connected to communications interface, Figure 1, Items 19 & 24; 11:30-12:20), an insertion tube (navigation tube, Figure 1, Item 49; 9:18-39) and an umbilical extending from the control body (Guide tube, Figure 1, Item 34; see 9:18-39), wherein at least one angulation cable (a belt disposed about each pulley, See Figure 11a, Items 420, 424, & 426; 17:55-65) extends from the user manipulatable angulation control, down the umbilical, to the tip of the insertion tube (see Figures 1 & 3; the belt {44} is understood to connect the communications device {24} at the interface device {60}, down guide tube {34} via its inner tube {56}, to the tip of the navigation tube {49}) such that movement of the angulation control changes the angulation of the tip (12:1-20), the umbilical being releasably attached to a main unit (at capture mechanism, Figure 3, Item 38; 12:38-67; see also 9:40-10:38), a motor within the instrument at the distal end of the umbilical (active motor attached to the carrier, see Figure 3, Item 60; 26:3-10) to apply a variable force to the cable (21:26-39), and

a position detector within the instrument to detect the angular position of the angulation control (encoders, all at 12:38-67) [Claim 1].

6. Alexander discloses wherein the position detector measures the rotation of the control [Claim 2] and the displacement of the cable [Claim 3] (rotational and translational encoders, 10:57-11:29) [Claims 2 & 3]. .

7. Alexander discloses wherein the position detector is located at the distal end of the umbilical (Figure 3, Items 30 & 31; 12:38-67) [Claim 4].

8. Alexander discloses wherein the instrument is provided with two pairs of angulation cables each pair forming a loop around the control body, and around a respective motor at the distal end of the umbilical (nested instruments having multiple carriage assemblies as described, Figure 15; 22:50-23:4; it is implied that each of the multiple carriages has a belt for selectively encoding the position of each nested instrument) [Claim 5].

9. Alexander discloses means provided to re-tension each loop (tension spring and spring screw, Figures 17a-b, Items 816 & 832; all at 23:26-24:44) [Claim 6].

10. Alexander discloses wherein a connector at the distal end of the umbilical is configured to provide a two-part release, allowing release to a partially released position in which the umbilical may be rotated relative to the base unit, but in which the weight of the umbilical is still supported by the base unit, and a second fully released position in which the umbilical is completely releasable from the base unit (all at 23:5-25; the first released position is understood to be when the navigation tube is in the guide tube but not yet captured; the fully released position is as removed from the guide tube) [Claim 7].

11. Alexander discloses wherein the position of each angulation cable is sensed by a combination of a low resolution absolute position detector and a higher resolution incremental encoder (potentiometer and optical encoder, both at 25:63-26:3; the pot is understood to be low

resolution and absolute, whereas the optical encoder is understood to be high resolution and incremental) [Claim 8].

Response to Arguments

12. Applicant's arguments filed 2/11/2011 have been fully considered but they are not persuasive. Alexander is understood to teach all of: a dummy instrument for use in a simulator (abstract), the instrument comprising a control body (Figure 1, Item 22; 9:28-39) with user manipulatable angulation control (Figure 1, Items 19 & 24; 11:30-12:20), an insertion tube (Figure 1, Item 49; 9:18-39) and an umbilical extending from the control body (Figure 1, Item 34; see 9:18-39), wherein at least one angulation cable (Figure 11a, Items 420, 424, & 426; 17:55-65) extends from the user manipulatable angulation control, down the umbilical, to the tip of the insertion tube (see Figures 1, Figure 3, Item 38; 12:38-67; see also 9:40-10:38), a motor within the instrument at the distal end of the umbilical (Figure 3, Item 60; 26:3-10) to apply a variable force to the cable (21:26-39), and a position detector within the instrument to detect the angular position of the angulation control (12:38-67). Thus, as Alexander appears to teach every element of the claim, broadly and reasonably and in light of the specification; Alexander is understood to anticipate the claim. Subsequently, applicant's arguments are not convincing.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIKOLAI A. GISHNOCK whose telephone number is (571)272-1420. The examiner can normally be reached on M-F 11:00a-7:30p EST (8:00a-4:30p PST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.